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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,125	07/17/2003	Lisa Corcoran	021919-000810US	4472
20350	7590	12/23/2004	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			ALIE, GHASSEM	
			ART UNIT	PAPER NUMBER
			3724	

DATE MAILED: 12/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/623,125	Applicant(s) CORCORAN ET AL.	
	Examiner Ghassem Alie	Art Unit 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/17/03(1,2 4-14)&02/23/04(3) is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>09/13/04</u> . | 6) <input type="checkbox"/> Other: _____  |

***Election/Restrictions***

1. Applicant's election of Group I (claims 1-3 and 6) filed on 07/27/04 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 2 and 3 have been canceled.

***Specification***

2. The disclosure is objected to because of the following informalities: on page 5, line 8, "the die 30" should be --a die 30--. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-3 and 6, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding Claim 1, "a commercial die press including a working area with a cutting height; a consumer die adapted to be located in the cutting area of a consumer press" is confusing. It is not clear whether a commercial die press or a consumer die press is claimed. It appears that claim 1 claims both a commercial die press and a consumer press. However, only one invention can be claimed in an application. It also appears that a commercial die press is being compared with a consumer press. The specific limitations of the invention are sufficient to differentiate the invention from a commercial die press and there is no need for claiming a commercial die press in conjunction with the

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consumer press. It is suggested that the applicant claim the characteristics or limitations of the consumer press, which appears to be the invention of the instant application, rather than claiming both a commercial die press and a consumer press in the same claim. In addition, "the consumer press with a cutting height smaller than the cutting height of the commercial press" is confusing. It is not clear what is the exact cutting height of the commercial press or the exact cutting height of the consumer press. The cutting heights of commercial presses are varied and all the commercial presses do not have the same cutting height. Is applicant suggesting that all the commercial presses have same cutting height? A commercial press can have a cutting height that could be smaller or larger than some other commercial presses. The phrase "a commercial press" is not clear. It is not clear what defines a commercial press. Are all the die presses defined as a commercial press?

Regarding claim 1, "the consumer press die" lacks antecedent basis. See claim 1, line 9.

Regarding claim 1, the claim ends with "consumer press die;" is confusing. It is not clear whether the claim is ended or not. It appears that the claim is incomplete.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3 and 6, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Beijen (5,778,748). Regarding claim 1, Beijen teaches a consumer die 30

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which is adapted to be located in the cutting area 25 of a consumer press 20 with a cutting height which appears to be smaller than the cutting height of a commercial presses. The cutting area of the consumer press inherently is smaller than some commercial press. Beijen also teaches that the consumer die 30 has a height that is custom or specific to the consumer press cutting area 25. Beijen also teaches an adaptor 44 having a height or thickness that is approximately equal to the difference between the height of a commercial die and the height of the consumer press die 30. The stationary plate 40 includes a plate 43 and a pad 44. The heights of the plate 42 and the pad 44 are specifically designed for cutting area 25 of the consumer press 22. The adaptor 44 creates a specific height for the consumer die 30, which inherently is different than the height of some of the commercial dies. See Figs. 1-9 and col. 5, lines 15-47 and col. 6, lines 9-54 in Beijen.

Regarding claim 2, Beijen teaches everything noted above including that the adaptor 44 has a cutting pad.

Regarding claim 3, Beijen teaches everything noted above including a cutting pad 44.

Regarding claim 6, Beijen teaches everything noted above including that the adaptor is attached to a die press platen 42. The adaptor includes the pad 44 and fasteners 46. The fasteners 46 attached the adaptor to die press platen 42.

To the degree that it could be argued that Beijen does not teach expressly that the cutting height of Beijen's consumer press is smaller than the commercial press the rejection below is applied.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

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Obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patent ability shall not be negative by the manner in which the invention was made.

8. Claims 1-3 and 6, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Beijen. Regarding claim 1, Beijen teaches a consumer die 30 which is adapted to be located in the cutting area 25 of a consumer press 20 having a cutting height. Beijen also teaches that the consumer die 30 has a height that is custom or specific to the consumer press cutting area 25. Beijen also teaches an adaptor 44 having a height or thickness. See Figs. 1-9 and col. 5, lines 15-47 and col. 6, lines 9-54 in Beijen.

Beijen does not expressly teach that the cutting area of the consumer press is smaller than a commercial press and the adaptor has a height or thickness that is approximately equal to the difference between the height of a commercial die and the height of the consumer press die. However, it would have been an obvious matter of design choice to provide the consumer press with a cutting height that is smaller than the cutting height of a commercial press or to provide the adapter with a height that compensates for the difference between the height of a commercial die and the height of the consumer press, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claim 2, Beijen teaches everything noted above including that the adaptor 44 has a cutting pad.

Regarding claim 3, Beijen teaches everything noted above including a cutting pad 44.

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Regarding claim 6, Beijen teaches everything noted above including that the adaptor is attached to a die press platen 42. The adaptor includes the pad 44 and fasteners 46. The fasteners 46 attached the adaptor to die press platen 42.

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Eichenberg et al. (5,255,587) and Smith (6,524,412 AND 2002/0124951) teach a consumer press having a consumer die.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ghassem Alie whose telephone number is (571) 272-4501. The examiner can normally be reached on Mon-Fri 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on (571) 727-4514. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

GA/ga

December 14, 2004

  
Allan N. Shoap  
Supervisory Patent Examiner  
Group 3700